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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,836	04/28/2000	James Grossman	204,307	4613
23413	7590	01/21/2004	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/560,836

Applicant(s)

GROSSMAN, JAMES

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 11-03-2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-14, 20-22, 24-37 and 40-45 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 and 24-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-14 and 40-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 20-22 and 24-37 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**Final Action**

1. This Office Action is in response to Correspondence dated 11-03-2003.  
(Response to restriction requirement).  
Claims 1-10, 15-19, 23, 38-39 are cancelled.  
Claims 20-22, 24-37 are withdrawn as non-elected. New claims 40-45 are added.  
Claims 11-14 are currently amended. Claims 11-14, 40-45 are now examined.

***Claim Rejections - 35 U.S.C. § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

**Examiner's Note:**

Several facts were Official Noted in the last Office Action (wherever the term "known" was used). These facts, where not seasonally challenged by the Applicants, i.e. in the next Response to the Office Action, are taken as admitted. MPEP 2144.03.

3. **Claims 11-14, 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clevenstine, US 6053536 hereinafter Clevenstine in view of Golden, US 5761648, herein Golden and further in view of Sparks et al. US 6167382.**

As to claims 11, 41-43:

Subsidized preprinted with ads/coupons mailer sheets are taught by Clevenstine.

Clevenstine discloses:

11. A method of distributing to a plurality of independent users, paper sheets, each sheet having at least one free field and bearing advertising messages sponsored by one or more advertisers that are unrelated to the users of the paper sheets, the method comprising the steps of:
  - a. providing a plurality of paper sheets having a per unit acquisition cost;
  - b. printing one or more advertisements on the plurality of printable paper sheets and leaving a printable field free of printed advertising on each of the plurality of sheets;( col 3l. 29-40)and
- d. distributing the wrapped packs of partially-printed paper to a plurality of users. (Fig 3-4 and associated text).

Clevenstine does not specifically disclose the papers are printable however discloses the mailers as used in mass mailings ( col 3 l. 47-55). Since printing content for mass mailings is known therefore it would be obvious content printing would have been added to the teachings of Clevenstine to efficiently effect mass mailings. Further Golden, US 5761648, Fig 1, discloses printing by individual printers by Applicant's invention time, therefore it would have been obvious to one skilled in the art at the time the invention was made to that have printable papers be added to Clevenstine to allow small business mailer users to print their content.

On the other hand, customized assembly of the mail piece via Internet with layout template control is taught by Sparks.

Sparks discloses:

A method of distributing printed advertising via the Internet to online Internet users comprising the steps of:

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- a. establishing an Internet website for receiving user identifying information (Fig. 1 and associated text);
- b. receiving and storing user identifying information transmitted by a plurality of users from remote computer terminals to thereby constitute a database of registered users (abstract, Fig 1-13 and associated text);

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the Sparks Internet document assembly into the Clevenstine in view of Golden system to use Internet efficiencies to do the ad targeting taught by Clevenstine at col. 4.

- c. thereafter electronically transmitting to registered users ( supplemental)advertising (claim 41) information that is formatted for marginal( claims 42, 43) printing on printable paper sheets by the registered user's printer when the registered user prints

As to printing advertising(supplemental information) marginally, Clevenstine discloses the partially-printed sheets have a central printable field and the one or more advertisements are printed in at least one marginal area (Fig 3 and associated text). Thus it would have been obvious to one skilled in the art at the time the invention was made to add Spark's internet assembly method to Clevenstine's teaching of printing the ads marginally so reserve a central area for content while taking advantage of the efficient Sparks' Internet document assembly method.

As to d. "recording printing of said supplemental advertising information formatted for marginal printing and increasing a credit account associated with said user based on printing of said supplemental (advertising) information formatted for marginal printing."

) Clevenstine discloses subsidized mailings (col 3 l. 35-40: i.e. each mailer costs the subsidizers so much) thus

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maintaining a record of the number of paper sheets on which advertising is marginally printed in association with each registered user's identifying information is obvious to add to Clevenstine's subsidized mailers teaching, to account for the subsidy to be given if the electronic method of subsidy is to be used. Official Notice was taken that such accounting methods are known, was unchallenged and therefore taken as admitted.

Further subsidies in terms of increasing a credit account is well-known. Thus increasing a user credit account based on the number of sheets printed with advertising printed would have been obvious at the time of the invention to efficiently effect payment of subsidies as taught by Clevenstine while taking advantage of the e-payment technologies. .

Claim 12. (dependent on 11) Clevenstine discloses subsidized mailings (col 3 l. 35-40: i.e. each mailer costs the subsidizers so much) thus maintaining a record of the number of paper sheets on which advertising is marginally printed in association with each registered user's identifying information is obvious to add to Clevenstine's subsidized mailers teaching, to account for the subsidy to be given if the electronic method of subsidy is to be used. Such accounting methods are known.

Further subsidies in terms of purchase credits is known. Payment after a certain accrued benefit has been rendered, for accounting convenience, is also known. Thus, transmitting to the user a printable credit device that is redeemable for the acquisition of goods and/or services when a predetermined number of paper sheets containing marginal advertising have been printed, would have been obvious to efficiently effect payment of subsidy as taught by Clevenstine.

Further transmitting to the user of the subsidy (purchase credits) via the registered user's e-mail address is known as another efficient payment method therefore obvious to add to Clevenstine and Sparks.

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Claim 13. (dependent on 12) where printed credit device is redeemable for the acquisition of printable paper sheets would be obvious as a subsidy method if the ads distributor and mailer distributor are affiliated as suggested in Clevensline.

Claim 14. (dependent on 11)

Clevensline discloses selective matching of ad categories by the mailer user ( col 4 1<sup>st</sup> para.) and Sparks discloses customized assembly thus :

transmitting to registered users indicia identifying a plurality of categories of products and services for which printed advertising is available; and  
storing any indicia in response to a selection transmitted to the website by a registered user indicating a registered user's preference for advertising of one or more categories of products and/or services.

would have been obvious to add as efficient assembly /tracking methods.

As to claim 40, Neither Clevensline nor Sparks teach

transmitting to registered users a printable credit device redeemable for the purchase of goods and/or services upon receiving said user identifying information (This limitation was part of previous claim 11).

However, Clevensline discloses subsidized mailings (i.e. each mailer costs the subsidizers so much). Official Notice was earlier taken that subsidies given in terms of purchase credits is known (last Office Action page 5, 3<sup>rd</sup> paragraph), was unchallenged and therefore taken as admitted. Therefore it would have been obvious to one skilled in the art at the time the invention was made to add such purchase credits subsidies into the Clevensline method when the user had paid for the sheets in full and the subsidy is to be given out as later.

Further giving out rewards for initiating experiencing advertising is well-known (see e.g. Goldhaber ) thus it would have been obvious to one skilled in the art at the time the invention was made to give the purchase credits at receiving said user identifying information to encourage use of the advertising system.

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As to claim 44, (dependent on claim 11) wherein said supplemental information is printed along with information downloaded via the Internet .

Clevenstine and Sparks, disclose, the method of claim 11.

Clevenstine and Sparks, disclose, as stated above partially preprinted sheets (Clevenstine) and personalized print orders via Internet (Sparks). It is also known the Sparks user device can be a personal computer and printer.

Also Sparks discloses:

- b. maintaining a relational database of information that is related to the printed fields of advertising and the fields of open spaces on the uniform partially-printed sheets (templates) (This feature is also implicit in Clevenstine in order to produce the partially preprinted mailers).

Sparks discloses downloading content from the Internet to fill in the template spaces, e.g. the open spaces with personalized content. It would have been obvious to one skilled in the art at the time the invention was made to add downloading content from the Internet to fill in the template spaces to allow the mail user, as taught by Clevenstine to add its own content which can be found on the Internet.

Claim 45. (dependent on claim 11) wherein said user may disable printing of said supplemental information.

Sparks can specify disabling printing in certain template slots. It would have been obvious to one skilled in the art at the time the invention was made to have disabling of ads printing when the user does not want to have ads on her mailer.

**Conclusion**

4. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

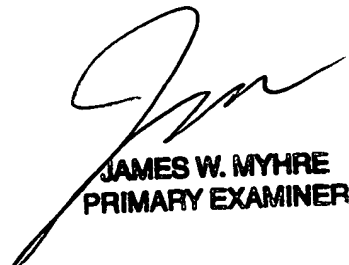
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Jan 12, 2004

KHL

KHL

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**